

C.) REMARKS

Status of the Claims

Claims 1-26 and 28-29 are pending in the application and claims 27 and 30 were previously withdrawn from consideration. Claims 1-29 stand rejected by the Examiner, however claim 27 was withdrawn in Applicant's September 8, 2003 Amendment under 37 C.F.R. § 1.114 (c) and acknowledgement thereof in the next Office Action is respectfully requested.

Claim Amendments

By this amendment claims 1 and 26 are amended. No new matter is added. Claims 1 and 26 have both been amended to change a grammatical error. Namely, the previous amendment to these claims mistakenly inserted the language "relative to one other," rather than "relative to one another." This correction has been made in the amendments provided herewith.

Claim Rejections

Claims 1-26 and 28-29 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over various combinations of prior art. Three criteria must be met to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. *See* MPEP § 2142 *et seq.* Applicant respectfully submits that the prior art of record, regardless of whether it is properly combined, fails to teach or suggest all of the features of the proposed amended claims and uses an improper combination of references, and therefore there is no *prima facie* case of obviousness.

A. McNichols in view of Oshefsky

The Examiner rejected claims 1-3 and 6-26 and 28-29 under U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,149,755 to McNichols, *et al.*

("McNichols") in view of U.S. Patent No. 4,578,133 to Oshefsky, *et al.* ("Oshefsky"). In the rejection, the Examiner acknowledges that McNichols does not disclose the feature that one or more applicator heads are mounted on fixed-length and fixed-angle arms. *See* Office Action, page 2. However, the Examiner alleges that the feature of one or more heads located on fixed-length and fixed-angle arms is well known in the art as shown, for example, in Oshefsky at column 6, line 38 to column 8, line 27 and Figure 3B. Office Action, page 2. Applicant hereby traverses the rejection for the following reasons.

McNichols discloses a combination roller (102),¹ that is used to cut a discrete workpiece (906) from an component web (912), and place it on a substrate web (903). McNichols, col. 11, ll. 5-23. The speed of the combination roller is selectively controlled and varied by a servomotor that has been programmed using a desired speed profile. *Id.* at col. 11, ll. 53-67. The speed profiles, depicted in Fig. 20, are designed to change the speed of the workpiece from a first speed (that of the component web) to a second speed (that of the substrate web). *Id.* at col. 12, ll. 8-43. Notably, McNichols discloses a combination roller having an essentially continuous drum-like surface structure, and fails to disclose separate arms and applicator heads. One deficiency of the McNichols design is that when the combination roller is decelerated to pick up each workpiece, the portion of the combination roller that is next to the substrate web moves slower than the substrate web, creating a potential to damage the substrate web by friction contact therewith. A similar differential speed and risk of damage is experienced at the component web when the combination roller is accelerated to the higher speed to deposit the workpiece on the substrate web.

¹ In order to prevent confusion regarding the reference numerals of the cited art and the reference numerals of the present invention, the prior art reference numerals are designated in parentheses.

Oshefsky discloses an apparatus for applying discrete strips of material to a moving web. There are two relevant embodiments of the Oshefsky device: one depicted in FIGS. 3A-C, and another depicted in FIGS. 4A-C. In both of these embodiments, the device includes a plurality of transfer members (30) that are arranged in a circular pattern about a rotatable shaft (38). During operation, elastics (16', 18') are attached to the transfer members (30) at a supply zone (S) by a pressure roller (52), then manipulated to the desired shape as the device rotates, and then deposited onto a moving web (24a) at a transfer zone (T) by a transfer roller (58). Oshefsky, col. 7, l. 25 - col. 8, l. 27. The difference between the two Oshefsky embodiments is that the embodiment of FIGS. 3A-C uses fixed-radius (*i.e.*, fixed-length) arms (48) to hold the transfer members, while the embodiment of FIGS. 4A-C uses variable-radius (*i.e.* variable-length) arms to hold the transfer members. *Id.* at col. 9, 3-15. Oshefsky explains that this variable-radius feature of the embodiment of FIGS. 4A-C "permits the utilization of independent linear supply speeds of the web 24a and elastic strips 16', 18." *Id.* at col. 9, ll. 18-24. Based on this disclosure it is clear, therefore, that Oshefsky did not contemplate that the embodiment of FIGS. 3A-C could be used to pick up elastics moving at one speed and deposit them at a different speed. It is also noteworthy that all of the Oshefsky embodiments place the supply pressure roller (52) at an angle relative to the transfer roller (58) that is equal to the angle between two of the arms (48) and their corresponding transfer devices (30), and therefore the supply and transfer operations must operate simultaneously. *See* Oshefsky FIGS. 3B, 4B and 5B.

In contrast to McNichols and Oshefsky, the present claims all recite the that the angle about the axis between the first (pick-up) location and the second (drop-off) location is *not* substantially equal to the predetermined angles between the applicator heads. This is shown throughout the Figures of the present disclosure.² For example, in

² Note that the embodiment of FIGS. 8 and 9a-c disclose multiple *separate sets* of arms in which each set of arms has multiple heads that are angularly fixed relative to (continued...)

FIG. 1, the pick-up location (roller 112) is at 90 degrees to the deposit location (web 102), whereas the angle between the heads is 180 degrees. Similarly, in FIG. 6a, the pick-up location is at about 135 degrees to the deposit location, while the angles between the heads are equal to 90 degrees, 180 degrees, and 270 degrees. The importance of this feature of the claimed invention is that it eliminates the possibility that the applicator heads 118 will contact either the discrete units 106 or the target web 102 while they are traveling at the wrong speed, which can cause physical damage to the parts, disrupt their movement, and/or misalign them for later operations.

Neither McNichols nor Oshefsky teaches or reasonably suggests this feature of the claimed invention. Instead, McNichols shows a continuous drum surface, and therefore there is no angle between the applicator heads, while Oshefsky discloses that the pick-up location and deposit location are at an angle equal to the angle between two of its applicator heads. Furthermore, if one were to modify the Oshefsky device of FIG. 3B as suggested by the Examiner, the Oshefsky device would not even function, because to work properly it would require the transfer device (30) at the supply pressure roller (52) to travel at the pickup speed, and the transfer device (30) at the transfer roller (58) to travel at the deposit speed *at the same time*. Of course, this would be impossible when the arms are fixed-length and fixed-angle as recited in the present claims and shown in Oshefsky FIG 3B. The impossibility of this operation also renders the combination of Oshefsky with McNichols improper under 35 U.S.C. § 103. *See In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *and M.P.E.P. § 2143.01*.

For at least the foregoing reasons, the combination of McNichols and Oshefsky fails to teach all of the features of the claimed invention, and the proposed combination is improper as a matter of law. As such, the combination does not support a *prima facie*

one another, but the different sets are not angularly fixed relative to one another. This essentially shows two embodiments of the present invention being operated face-to-face in unison with one another.

case of § 103 obviousness under 35 U.S.C. § 103. Accordingly, the Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-3, 6-26 and 28-29.

B. McNichols in view of Oshefsky and Killian

The Examiner rejected claims 4 and 5 under U.S.C. § 103(a) as allegedly being unpatentable over McNichols, in view of Oshefsky, and further in view of U.S. Patent No. 5,850,711 to Killian ("Killian"). Applicant traverses the Examiner's objection for at least the following reasons.

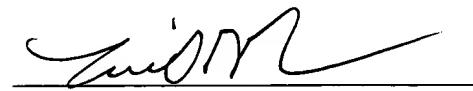
With respect to claims 4 and 5, the Examiner acknowledges that McNichols does not disclose devices such as a mechanical gripping device or a combination of gripping devices, but that this feature is well known and conventional as shown, for example, by Killian. Office Action, page 4. As discussed above, McNichols and Oshefsky fail to teach all of the claimed features of the proposed amended claims. Killian fails to remedy the deficiencies of McNichols and Oshefsky because it also fails to teach or suggest the claimed features described above. Therefore, the references in combination do not teach or suggest all the elements of the claims, and do not support a *prima facie* case of obviousness. Accordingly, the Applicant respectfully requests that the Examiner reconsider and withdraw this rejection and allow claims 4 and 5.

Conclusion

For at least the reasons provided above, Applicant submits that the application is in condition for allowance. Entry of the amendments and favorable reconsideration and allowance of the pending claims are respectfully solicited. Should there be any questions regarding the foregoing, the Examiner is invited to contact the applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,
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